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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,394	10/24/2001	Mark J. Pellerite	56059US009	7743

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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT PAPER NUMBER

1773

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/037,394

Applicant(s)

PELLERITE ET AL.

Examiner

Ramsey Zacharia

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 705.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 14, 15, 23, 24, 26, 27, 29, 30, 32, 33, 35, 36, 38 and 39.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

RESPONSE TO ARGUMENTS

1. The applicants request that the finality of the rejection be withdrawn because they have not had an opportunity to respond to the new grounds of rejection.

This request is not granted because the rejection was not made final prematurely. The new grounds of rejection were necessitated by the applicants' amendment narrowing the range of n from "about 4" (which includes values above 4 in addition to 4 and values below 4) to "1 to 4".

2. The request for reconsideration has been considered but does not place the application in condition for allowance for the following reasons. The applicants argue that one of ordinary skill looking at Diesslin et al. and the prior art as a whole would conclude that only those fluorocarbon acid and derivatives of Diesslin et al. having a fluorocarbon tail that projects outwardly a substantial distance would be suitable for use as a surface treatment for optical elements to induce float and not those having 1 to 4 fluorinated carbon atoms as claimed.

This is not persuasive because Diesslin et al. explicitly teaches that acyclic fluorocarbon acid and derivatives having a tail of $-C_nF_{2n+1}$ where n is 3 or higher are suitable for use as surface active agents. See column 2, lines 8-44, particularly lines 14-16 and 19-30. That is, Diesslin et al. explicitly teach that acyclic fluorocarbon acid and derivatives having a tail of $-C_nF_{2n+1}$ where n is 3 or higher (including $-C_3F_7$) have fluorocarbon tails that project outwardly a substantial distance.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (703) 305-0503. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ramsey Zacharia
Primary Examiner
Tech Center 1700